

REMARKS

Claims 11-42 are pending in the present application.

Claims 1-10 have been previously canceled without *prejudice*.

Claims 11-16, 18, 27-32, and 34 stand rejected under 35 U.S.C. § 103(a) over EP 425,405 A2 to James et al. (“*James*”) in view of U.S. Patent No. 5,459,656 to Fields et al. (“*Fields*”) and in further view of “The keys to the enterprise: integrated applications drive information systems to new horizons – enterprise wide integration” to Dusty Rhodes (“*Rhodes*”).

Claims 17, 19-26, 33, 35-37, and 39-42 stands rejected under 35 U.S.C. § 103(a) over *James* in view of *Fields* and *Rhodes* and in further view of “Dun & Bradstreet Software Delivers Sales and Promotion System to Manufacturers” to Frank O. Smith (“*Smith*”).

Applicant respectfully submits that all of Applicant’s arguments and amendments are without prejudice or disclaimer. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner's rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 11-16, 18, 27-32, and 34 stand rejected under 35 U.S.C. § 103(a) over *James* in view of *Fields* and in further view of *Rhodes*. Claims 17, 19-26, 33, 35-37, and 39-42 stand rejected under 35 U.S.C. § 103(a) over *James* in view of *Fields* and *Rhodes* and in further view of *Smith*.

Applicant respectfully submits that *James, Fields, or Rhodes*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 11-16, 18, 27-32, and 34. Applicant further respectfully submits that *James, Fields, Rhodes, or Smith*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 17, 19-26, 33, 35-37, and 39-42. Thus, Applicant respectfully traverses the Examiners obvious rejection of Claims 11-42 under 35 U.S.C. § 103(a) over the proposed combination of *James, Fields, Rhodes, or Smith*, either individually or in combination.

The proposed *James-Fields-Rhodes-Smith* Combination Fails to Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to independent Claim 11, this claim recites:

A computer-implemented system for managing data associated with available-to-promise (ATP) products, comprising:

a memory to store a *hierarchy of at least two seller models that each represent a seller for one or more products*, each product associated with a *product forecast model* representing:

forecasted sales of the product through the seller;

planned supply of the product;

customer orders for the product through the seller; and

pre-allocated supply of the product to the seller, the pre-allocated supply being a supply of the product that has been pre-allocated to the seller for promising to subsequent customer orders for the product through the seller, the pre-allocation of the supply of the product to the seller occurring prior to distribution of the pre-allocated supply of the product to the seller; and

a processor coupled with the memory, the processor *computes the amount of the product that is ATP at a seller according to at least the planned supply of the product*, the customer orders for the product through the seller, the pre-allocated supply of the product to the seller, and the amount of the product that is ATP at one or more other sellers at a higher level in a seller hierarchy. (Emphasis Added).

In addition, *James, Fields, Rhodes, or Smith*, either individually or in combination fail to disclose each and every limitation of dependent Claims 19, 27, and 35.

The Office Action Acknowledges that *James* Fails to Disclose Various Limitations Recited in Applicant's Claims

Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *James* fails to disclose various limitations recited in independent Claim 11. Specifically the Examiner acknowledges that:

James does not explicitly disclose ***two seller models that each represent a seller for one or more products each product being associated with a product forecast model; and forecasted sales of the product through the seller.***

(20 August 2008 Final Office Action, page 3). (Emphasis Added). However, the Examiner asserts that the cited portions of *Fields* disclose the acknowledged shortcomings in *James*. Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Fields*.

Applicant respectfully submits that *Fields* fails to disclose, teach, or suggest independent Claim 11 limitations regarding a “***hierarchy of at least two seller models that each represent a seller for one or more products***, each product associated with ***a product forecast model*** representing [...] forecasted sales of the product through the seller”. In particular, the Examiner states:

With regard to the 35 U.S.C. 103 rejections, the applicants argue that *Fields* does not teach “at least two seller models that each represent a seller for one or more products” wherein each product is associated with a “product forecast model”. However, ***Fields clearly discloses two seller models*** (*Fields*: Col. 2, Ln. 1-9).

(20 August 2008 Final Office Action, page 19). (Emphasis added). By contrast, the cited portion of *Fields* on which the Examiner relies does not disclose a “***hierarchy of at least two seller models that each represent a seller for one or more products***, each product being associated with ***a product forecast model*** representing [...] forecasted sales of the product through the seller,” as recited in independent Claim 11 but is merely the “BACKGROUND OF THE INVENTION” portion of *Fields* and the first 4 lines of the “SUMMARY OF THE INVENTION” portion of *Fields*. (Column 2, Lines 1-9). (Emphasis added). In fact, Applicant respectfully directs the Examiner's attention to the cited portion of *Fields*, on which the Examiner relies:

[...] unusually large order is placed. What is needed is method of adjusting the projected demand levels in future intervals in proportion to both historical demand trends and current actual demand.

SUMMARY OF THE INVENTION

The present invention provides a system and method for analyzing business demand which incorporates tracking of past business demand for a ***plurality of products or tasks***, time intervals during the day, and other factors, storing...

(Column 2, Lines 1-9). (Emphasis added). Applicant respectfully submits that the Examiner has mischaracterized the cited portion of *Fields*. For example, as noted above, the Examiner states that “***Fields clearly discloses two seller models.***” (20 August 2008 Final Office Action, page 19). (Emphasis added). However, Applicant finds no such teachings anywhere in *Fields* and certainly not in the cited columns and lines of *Fields*, relied on by the Examiner. Applicant respectfully submits that *Fields* does not disclose “***two seller models,***” as alleged by the Examiner and respectfully request the Examiner to point to the portion or portions of *Fields* that “***clearly discloses two seller models,***” as alleged by the Examiner. In addition, if “***Fields clearly discloses two seller models,***” as alleged by the Examiner, then *Fields* will expressly disclose the term “***two seller models,***” somewhere in the specification of *Fields*. However, as discussed above, *Fields* does not expressly or even impliedly disclose the term “***two seller models***” and therefore, *Fields* clearly does not disclose “***two seller models,***” as alleged by the Examiner.

Applicants further respectfully submit that even for the sake of argument, if *Fields* did close the term “***two seller models,***” somewhere in the specification, which it does not, it clearly does not, *Fields* still fails to disclose a “***hierarchy of at least two seller models that each represent a seller for one or more products,***” as recited in independent Claim 11. Applicant respectfully submits that the Examiner is silent as to the limitation of a “***hierarchy of at least two seller models that each represent a seller for one or more products***”. Thus, Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between the *Fields* and independent Claim 11 cannot be made. Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 11 from *Fields*.

In addition, the Examiner alleges:

Fields discloses at least two seller models that each represent a seller for one or more products (i.e. the model ***should cover*** each of a plurality of products or business items to determine future business demand for a specific location) (col. 2, lines 1-9).

(20 August 2008 Final Office Action, page 19). (Emphasis added). By contrast, the cited portion of *Fields* on which the Examiner relies does not disclose that “the model ***should cover*** each of a plurality of products or business items to determine future business demand for a specific location,” as asserted by the Examiner, but instead merely states as shown above, that the “present invention [of *Fields*] provides a system and method for analyzing business demand which incorporates tracking of past business demand for a ***plurality of products or tasks***, time intervals during the day, and other factors.”

Applicant respectfully submits that the Examiner has mischaracterized the cited portion of *Fields*. For example, as noted above, the Examiner states that “the model ***should cover*** each of a plurality of products.” (20 August 2008 Final Office Action, page 19). (Emphasis added). However, Applicant finds no such teachings anywhere in *Fields* and certainly not in the cited columns and lines of *Fields*, relied on by the Examiner. Applicant respectfully submits that *Fields* does not disclose that “the model ***should cover*** each of a plurality of products,” as alleged by the Examiner and respectfully requests the Examiner to point to the portion or portions of *Fields* that states that “the model ***should cover*** each of a plurality of products,” as alleged by the Examiner.

In fact, Applicant respectfully submits that *Fields* actually teaches away from Applicants claimed invention. For example, *Fields* discloses that in “addition to the impracticality of computing business demand manually on a more frequent basis is the complexity introduced by different demand patterns for each day of the week, seasons of the year, or other recurring events.” (Column 1, line 24 through column 2, line 1). In addition, “[a]ccommodating this level of complexity requires storing and using the past business demand according to a model that accounts for the seasonality, day of the week and time intervals during the business day, for each of a plurality of products or business items to determine future business demand for a specific location” and “the difficulty encountered once the past business demand has been stored is the ability to deal with incomplete data from current time periods and to compare trends in [...] time intervals against projected demand in equal time intervals.” (Column 1, line 24 through column 2, line 1). However,

the method for making such comparisons is “unreliable given the many anomalies that can occur, for example, when a bus load of people arrives or an unusually large order is placed.” (Column 1, line 24 through column 2, line 1). Thus, *Fields* cannot disclose that “the model ***should cover*** each of a plurality of products or business items to determine future business demand for a specific location,” as asserted by the Examiner, for at least the reason *Fields* states that the model in *Fields* that is used for accommodating this level of complexity further needs a method for making such comparisons and is unreliable given the many anomalies that can occur. Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Fields* and independent Claim 11 cannot be made. Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 11 from *Fields*.

The Examiner further alleges that:

Fields contemplates that a model can cover a plurality of business items...

(20 August 2008 Final Office Action, page 19). (Emphasis added). By contrast, the cited portion of *Fields* on which the Examiner relies does not “***contemplate that a model can cover a plurality of business items***,” as alleged by the Examiner but rather merely describes a “needed [...] method of adjusting [...] projected demand levels.” (Column 2, Lines 1-9). (Emphasis added). However, this “needed [...] method of adjusting [...] projected demand levels,” as disclosed in *Fields* does not include, involve, or even relate to “***contemplate[ing] that a model can cover a plurality of business items***,” as alleged by the Examiner. Applicant respectfully submits that the Examiner’s equation is inaccurate, that is the “needed [...] method of adjusting [...] projected demand levels” as disclosed in *Fields*, does not equate to “***contemplate[ing] that a model can cover a plurality of business items***,” as alleged by the Examiner because, among other things, the “needed [...] method” of *Fields* is only a “needed [...] method of adjusting [...] projected demand levels.”

In addition, as discussed in detail above, *Fields* merely states that “[a]ccommodating this level of complexity requires storing and using the past business demand according to a model that accounts for the seasonality, day of the week and time intervals during the business day, for each of a plurality of products or business items to determine future business demand for a specific location.” (Column 1, line 24 through column 2, line 1). However, the Examiner’s assertion that *Fields* “***contemplates that a model can cover a plurality of business items***” is inaccurate, that is

“storing and using the past business demand according to a model” as discussed in *Fields* does not equate to the Examiner’s allegations that “Fields ***contemplates that a model can cover a plurality of business items.***” Applicants respectfully request the Examiner to verify the references to *Fields*, to ensure that some mistake has not been made.

Furthermore, Applicant further respectfully requests clarification as to what the Examiner means by “Fields ***contemplates that a model can cover a plurality of business items.***” For example, what does the Examiner mean by “Fields ***contemplates***” what is ***contemplated*** mean and how does the Examiner purport that the mere ***contemplation*** applies to the subject application. In addition, what does the Examiner mean by a “***model can cover a plurality of business items***” does the Examiner mean that the term “***can***” means it does or does not and what does the Examiner mean by “***cover***” and how does the Examiner purport that the mere ***contemplation*** applies to the subject application. Thus, Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between the *Fields* and independent Claim 11 cannot be made. Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 11 from *Fields*.

Furthermore, the Examiner alleges that:

[...] ***the Office, therefore, takes the position that*** this means that the ***model*** disclosed in *Fields* ***can be applied to many different business items wherein each item is covered by a model.***

(20 August 2008 Final Office Action, page 19). (Emphasis added). By contrast, the cited portion of *Fields* on which the Examiner relies does not “mean[] that the [alleged] ***model*** disclosed in *Fields* ***can be applied to many different business items wherein each item is covered by a model,***” as alleged by the Examiner. In fact, as discussed above, the cited portion of *Fields*, on which the Examiner relies merely describes a “needed [...] method of adjusting [...] projected demand levels.” (Column 2, Lines 1-9). (Emphasis added). Applicant respectfully request the Examiner to verify the references to *Fields*, to ensure that some mistake has not been made.

In addition, it appears that the Examiner’s conclusory allegation that “***the Office, therefore, takes the position that*** this means that the ***model*** disclosed in *Fields* ***can be applied to many different business items wherein each item is covered by a model***” may be an assertion of Official

Notice. (20 August 2008 Final Office Action, page 19). (Emphasis added). However, Applicant respectfully submits that Applicant is confused as to what the Examiner is attempting to teach by the Examiner's conclusory allegation or even to the extent in which the Examiner is attempting to take Official Notice. Applicants respectfully request clarification as to the subject matter for which Official Notice is being taken. *Applicant respectfully traverses the Official Notice because the asserted facts*, as best understood by Applicant, *are not supported by substantial documentary evidence or any type of documentary evidence* and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion. (See MPEP § 2144.03). *Applicant respectfully requests the Examiner to produce authority for the Examiner's purported Official Notice.*

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence *should only be taken by the examiner* where the facts asserted to be well-known, or to be common knowledge in the art are *capable of instant and unquestionable demonstration as being well-known*."

With respect to the subject Application, the Examiner's statement that the "*the Office, therefore, takes the position that* this means that the *model* disclosed in *Fields can be applied to many different business items wherein each item is covered by a model*," *is not capable of instant and unquestionable demonstration as being well-known*. (20 August 2008 Final Office Action, page 19). (Emphasis added). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '*capable of such instant and unquestionable demonstration as to defy the dispute*' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is *never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record*, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic

knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).” (MPEP § 2144.03(A)).

“Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that ***general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection***). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

Applicant respectfully submits that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. Applicant further respectfully submit that Applicant has adequately traversed the Examiners assertion of Official Notice and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Applicants Claims based on the Examiner’s purported Official Notice, Applicant respectfully requests that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is

relying on personal knowledge to support the finding of what is known in the art, Applicant further respectfully requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

Still furthermore, the Examiner alleges:

Therefore, since Fields disclose a plurality of items that can be covered by its model it ***inherently discloses a plurality (including two) seller models***. It is ***entirely possible*** that the two products Fields mentions in the above cited passages come from two different sellers.

(20 August 2008 Final Office Action, page 19). (Emphasis added). By contrast, the cited portion of *Fields* on which the Examiner relies clearly does not make it “***entirely possible*** that the two products Fields mentions in the above cited passages [Column 2, Lines 1-9] come from two different sellers,” as alleged by the Examiner. In fact, the only reference to “***products***” that the cited portion of *Fields* refers to is the “present invention provides a system and method for analyzing business demand which incorporates tracking of past business demand for a ***plurality of products or tasks***, time intervals during the day, and other factors, storing.” (Column 2, Lines 1-9). (Emphasis added). However, “tracking of past business demand for a ***plurality of products or task***,” as disclosed in *Fields* does not include, involve, or even relate to making it “***entirely possible*** that the two products Fields [...] come from two different sellers.

In addition, Applicant respectfully submits that the Examiner’s “***entirely possible***” test is not a valid test under current patent rules or current patent law. ***Applicant respectfully requests the Examiner to cite a specific rule in 37 C.F.R. or in the MPEP that describes the Examiner’s “entirely possible” test.*** The Examiner may call the undersigned, Steven J. Laureanti, at (480) 830-2700 if the Examiner believes it would be easier to discuss the “***entirely possible***” test, over the telephone.

In addition, as noted above, the Examiner states that *Fields* “***inherently discloses a plurality (including two) seller models***.” (20 August 2008 Final Office Action, page 19). (Emphasis added). ***Applicant*** respectfully disagrees and ***respectfully traverses the Examiner’s assertions regarding the purported inherent features in Fields***. Applicant respectfully submits that the Examiner is

using the subject Application as a template to formulate reconstructive hindsight to reach this conclusion and reconstructive hindsight is improper under 35 U.S.C. § 103. An anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. (*In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). With respect to the subject Application, the Examiner acknowledges and Applicant agrees that the ***Fields does not disclose every limitation of independent Claim 11*** in the same relationship to one another as set forth in independent Claim 11.

To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, ***inherency requires that the asserted proposition necessarily flow from the disclosure***. (*In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986)). ***It is not enough that a reference could have, should have, or would have been used as the claimed invention***. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (*Oelrich*, at 326, quoting *Hansgirk v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789). (Emphasis Added). ***Inherency ... may not be established by probabilities or possibilities***. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (*Skinner*, at 1789, citing *Oelrich*). (Emphasis Added). Where anticipation is found through inherency, the ***Office’s burden of establishing prima facie anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.”*** (*Skinner* at 1789). (Emphasis Added).

With respect to the subject application, Applicant respectfully submits that the Examiner’s assertion is ***not supported by scientific reasoning and/or any type of evidence*** and appears to be the Examiner’s opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. In fact, the Examiner’s statement that *Fields* “***inherently discloses a plurality (including two) seller models***”, is merely a fact that a certain thing may result from a given set of circumstances and is clearly insufficient. (20 August 2008 Final Office Action, page 19). (Emphasis added).

Thus, if the Examiner continues to maintain the rejection of Claims 11-42 based on inherency, Applicant respectfully requests that the Examiner provide *evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art.*

The Office Action Also Acknowledges that *James* Fails to Disclose Other Limitations Recited in Applicant's Claims

Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *James* fails to disclose various limitations recited in independent Claim 11. Specifically the Examiner acknowledges that:

James does not explicitly disclose *pre-allocated supply of the product to the seller and the system operable to compute the amount of the product that is ATP at the seller according to the planned supply, the customer orders, the pre-allocated supply and the amount of the product that is ATP at one or more sellers at a higher level in a seller hierarchy.*

(20 August 2008 Final Office Action, page 3). (Emphasis added). However, the Examiner asserts that the cited portions of *Rhodes* disclose the acknowledged shortcomings in *James*. Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Rhodes*.

Applicants respectfully submit that *Rhodes* fails to disclose, teach, or suggest independent Claim 11 limitations regarding a “*product forecast model*” representing “*pre-allocated supply of the product to the seller*”, the pre-allocated supply being a supply of the product that has been pre-allocated to the seller for promising to subsequent customer orders for the product through the seller, the pre-allocation of the supply of the product to the seller occurring prior to distribution of the pre-allocated supply of the product to the seller” and “*comput[ing] the amount of the product that is ATP at a seller according to at least the planned supply of the product*”, the customer orders for the product through the seller, the pre-allocated supply of the product to the seller, and the amount of the product that is ATP at one or more other sellers at a higher level in a seller hierarchy”.

In particular, the Examiner states:

However, Rhodes discloses pre-allocated supply of the product to the seller (i.e *plan sales expectations*)(pages 1 and 2)

(20 August 2008 Final Office Action, page 3). (Emphasis added). By contrast, the cited portion of *Rhodes* on which the Examiner relies does not disclose a “*product forecast model*” representing “*pre-allocated supply of the product to the seller*, the pre-allocated supply being a supply of the product that has been pre-allocated to the seller for promising to subsequent customer orders for the product through the seller, the pre-allocation of the supply of the product to the seller occurring prior to distribution of the pre-allocated supply of the product to the seller”, as recited in independent Claim 11. In fact, Applicant respectfully directs the Examiner’s attention to the cited portion of *Rhodes*, on which the Examiner relies:

Sales and operations planning (SOP) software can help establish manufacturing output, *plan sales expectations* and meet business needs such as inventory balancing, employee scheduling, productivity, finance and engineering.

(Page 1). As clearly shown above, *Rhodes* does not teach, suggest, or even hint at “*pre-allocated supply of the product*,” as recited in independent Claim 11 but rather merely discusses that the SOP “software can help establish manufacturing output, *plan sales expectations* and meet business needs.” However, “software [that] can help establish [...] *plan sales expectations* does not include, involve, or even relate to “*pre-allocated supply of the product*,” as recited in independent Claim 11. In contrast, the “*pre-allocated supply of the product to the seller*” as recited in independent Claim 11 is a “supply of the product that has been pre-allocated to the seller for promising to subsequent customer orders for the product through the seller, the pre-allocation of the supply of the product to the seller occurring prior to distribution of the pre-allocated supply of the product to the seller.” Applicant respectfully requests the Examiner to verify the references to *Rhodes*, to ensure that some mistake has not been made.

In addition, the Examiner alleges:

The system of Rhodes enables a user to satisfy the current level of sales, therefore, in order to satisfy a level of sales the system of Rhodes must necessarily “*compute the amount of product*” otherwise how would Rhodes inform a user on how to “satisfy the current planned level of sales.” The applicants argue that “the equations forming the foundation of the Examiner's comparison between Rhodes and independent Claim 11 cannot be made.” It is not clear to the Office what the

applicants are intending to argue from this quoted language. The Office has not cited to any equations in Rhodes in the rejection of Claim 11 and in fact the Office is citing to passages in Rhodes in the rejection of Claim 11 which teach a means to “compute the amount of product”.

(20 August 2008 Final Office Action, page 19). By contrast, the cited portion of *Rhodes* on which the Examiner relies does not disclose “*comput[ing] the amount of the product that is ATP at a seller according to at least the planned supply of the product*, the customer orders for the product through the seller, the pre-allocated supply of the product to the seller, and the amount of the product that is ATP at one or more other sellers at a higher level in a seller hierarchy”, as recited in independent Claim 11 but rather merely provides for the SOP process to better satisfy the current planned level of sales, but *does not include, involve, or even relate to computing the amount of the product*, as recited in independent Claim 11. (Page 1). (Emphasis Added). In contrast, “*comput[ing] the amount of the product*” recited in independent Claim 11 is provided for *computing at a seller according to at least the planned supply of the product*, the customer orders for the product through the seller, the pre-allocated supply of the product to the seller, and the amount of the product that is ATP at one or more other sellers at a higher level in a seller hierarchy.” Applicant respectfully requests the Examiner to verify the references to *Rhodes*, to ensure that some mistake has not been made.

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *James-Fields-Rhodes-Smith* Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *James*, *Fields*, *Rhodes*, or *Smith*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law

based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “***ensure that the written record includes findings of fact*** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “***factual findings made by Office personnel are the necessary underpinnings to establish obviousness.***” (*id.*). Further, “***Office personnel must provide an explanation to support an obviousness rejection*** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the ***factual findings necessary to establish obviousness*** or even ***an explanation to support the obviousness rejection*** based on the proposed combination of *James, Fields, Rhodes, and Smith*. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to include the teachings of Fields within the James system [and] to include the features as disclosed by Rhodes within the James and Fields combination”. (20 August 2008 Final Office Action, pages 3-4). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the ***factual findings necessary to establish obviousness*** and is not a sufficient ***explanation to support the obviousness rejection*** based on the

proposed combination of *James, Fields, Rhodes, and Smith*. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided *an indication of the level of ordinary skill*. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that *Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.* (*Id.*). In addition, the Guidelines state that the proper analysis is *whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.* (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant’s invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to *explain why the difference(s) between the proposed combination of James, Fields, Rhodes, Smith and Applicant’s*

claimed invention would have been obvious to one of ordinary skill in the art. The Office Action merely states that “in order to provide products in timely response to customer demands” and for “allowing access to relevant data, facilitating fast decision making and providing material and resource management information to sales and marketing teams.” (20 August 2008 Final Office Action, pages 3-4). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement *explains why the difference(s) between the proposed combination of James, Fields, Rhodes, Smith and Applicant’s claimed invention would have been obvious to one of ordinary skill in the art.* Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant's claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of James, Fields, Rhodes, and Smith to render obvious Applicant's claimed invention*. The Examiner's unsupported conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the teachings of Fields within the James system [and] to include the features as disclosed by Rhodes within the James and Fields combination" and "in order to provide products in timely response to customer demands" and for "allowing access to relevant data, facilitating fast decision making and providing material and resource management information to sales and marketing teams", *does not adequately provide clear articulation of the reasons why Applicant's claimed invention would have been obvious*. (20 August 2008 Final Office Action, pages 3-4). In addition, the Examiner's unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *James, Fields, Rhodes, and Smith*, *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines*.

Applicant's Claims are Patentable over the Proposed *James-Fields-Rhodes-Smith* Combination

Applicant respectfully submits that independent Claim 11 is considered patentably distinguishable over the proposed combination of *James, Fields, Rhodes, or Smith*. This being the case, independent Claims 19, 27, and 35 are also considered patentably distinguishable over the

proposed combination of *James, Fields, Rhodes*, or *Smith*, for at least the reasons discussed above in connection with independent Claim 11.

Furthermore, with respect to dependent Claims 12-18, 20-26, 28-34, and 36-42; Claims 12-18 depend from independent Claim 11; Claims 20-26 depend from independent Claim 19; Claims 28-34 depend from independent Claim 29; and Claims 36-42 depend from independent Claim 35. As mentioned above, each of independent Claims 11, 19, 27, and 35 are considered patentably distinguishable over *James, Fields, Rhodes*, or *Smith*. Thus, dependent Claims 12-18, 20-26, 28-34, and 36-42 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 11-42 are not rendered obvious by the proposed combination of *James, Fields, Rhodes*, or *Smith*. Applicant further respectfully submits that Claims 11-42 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 11-42 under 35 U.S.C. § 103(a) be reconsidered and that Claims 11-42 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed electronically herewith to facilitate the processing of this deposit account authorization. **The Director is hereby authorized to charge the \$810.00 RCE fee to Deposit Account No. 500777.** Although the Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.** If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

20 November 2008
Date

/Steven J. Laureanti/signed
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